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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/659,199

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Stephen M. Allen

BB1157 US CNT

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03/23/2009

POTTER ANDERSON & CORROON LLP

ATTN: KATHLEEN W. GEIGER, ESQ.

P.O. BOX 951

WILMINGTON, DE 19899-0951

EXAMINER

KUBELIK, ANNE R

ART UNIT

PAPER NUMBER

1638

MAIL DATE

DELIVERY MODE

03/23/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<p align="center"><b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b></p>	<p><b>Application No.</b> 10/659,199</p>	<p><b>Applicant(s)</b> ALLEN ET AL.</p>	
	<p><b>Examiner</b> Anne R. Kubelik</p>	<p><b>Art Unit</b> 1638</p>	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 02 March 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: \_\_\_\_\_.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

/Anne R. Kubelik/  
Primary Examiner, Art Unit 1638

Continuation of 11. does NOT place the application in condition for allowance because:

112, 1<sup>st</sup>, written description:

Applicant urges that the correlation between DNA sequences and protein sequence is well known, citing a reference not of record, and there is a high level of skill in the art. This is not found persuasive because the specification must teach the structural elements of the protein that confer Brittle-1 activity. The correlation between DNA sequences and Brittle-1 activity is not well known, and not described in the specification.

112, 1<sup>st</sup>, enablement (arguments mixed in the written description arguments):

Applicant urges that the office action admits the specification is an enabling for the nucleic acids, citing portions of what is presumed to be the Office action mailed 3 December 2008. This is not found persuasive because the first of these citations states that while nucleic acid encoding SEQ ID NO:18 are enabled, the full scope of the claims, which includes nucleic acids encoding a protein with 95% identity to SEQ ID NO:18, are not enabled. The second citation states there is no assay for Brittle-1 activity.

Applicant urges that the office seems to be stating that testing of variants is sufficiently deterrent from testing the native protein; one of skill in the art would not test all variants, only ones they had a particular interest in. This is not found persuasive because the native protein does not need to be tested - Applicant has already taught it. The specification does not teach which variants those of skill in the art should have an interest in, or how to assay them.

103:

Applicant urges that the sequence of the wheat gene cannot be anticipated by a statement that it would be obvious to isolate homologs based on a sequence from another plant. This is not found persuasive because it would be obvious to one of skill in the art to isolate the wheat brittle-1 gene better study starch synthesis and the function of the protein; further, it would be obvious to isolate it to procure another transit peptide that targets proteins to the inner amyloplast membrane. Anticipation does not come into play in an obviousness rejection.

Applicant urges that Sullivan provides no motivation to search for a monocot Brittle-1 different from the one they teach. This is not found persuasive because the motivation is found in the need of research to better study starch synthesis and the function of the protein and isolate additional transit peptides. The motivation does not have to come directly from Sullivan.

Applicant urges that the primary reference is overcome. This is not found persuasive because it has not been overcome.

Applicant urges that Li is not prior art under 102(b) and cannot be used under 103. This is not found persuasive because all prior art available under 35 U.S.C. 102 is available under 35 U.S.C. 103 (see MPEP 2141.01), even 102(a) art.